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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Rolf Kohler

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EXAMINER

TRAN, PHILIP B

ART UNIT

PAPER NUMBER

2155

MAIL DATE

DELIVERY MODE

02/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/856,905

Applicant(s)

KOHLER ET AL.

Examiner

Philip B. Tran

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

Notice to Applicant

1. This communication is in response to Amendment filed 22 October 2007. Claim 12 has been amended. Claims 19-20 have been newly added. Therefore, claims 10-20 are pending for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 19, it is unclear how to suppress the at least two different functions is done without resetting any hardware arrangement while claim 10 (independent claim) discloses suppressing the other ones of the at least two different functions.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries

include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

(1) Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had possession of the invention on the filing date of the application. The application need not describe the claim limitations exactly, but must be sufficiently clear for one of ordinary skill in the art to recognize that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 19 and 20:

- **wherein suppressing the at least two different functions is done without resetting any hardware arrangement.**
- **wherein the other function is suppressed without resetting any hardware arrangement.**

Therefore, claims 19 and 20 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claimed negative limitations. Applicant is requested to point out where in the specification of the instant application supports above claimed negative limitations in claims 19 and 20.

(2) Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. A skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in

addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice the following steps as recited in claims 19 and 20:

- **wherein suppressing the at least two different functions is done without resetting any hardware arrangement.**
- **wherein the other function is suppressed without resetting any hardware arrangement.**

Undue experimentation would be needed to make a suppressing the at least two different functions without resetting any hardware arrangement. If, however, the above limitations are not supported by the instant application's specification, then it is unclear how experiment can be carried out to make a suppressing the at least two different functions without resetting any hardware arrangement.

Claim Rejections - 35 U.S.C. § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 10-13 and 15-18 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ardon et al (Hereafter, Ardon), U.S. Pat. No. 5,105,420.

Regarding claim 10, Ardon teaches a method for selecting a function to be implemented at a terminal of a control unit, the method comprising the steps of selecting

the function to be implemented from one of at least two different functions by using a pre-definable code (software module) [see Figs. 1 & 4a-4b & 6 and Col. 5, Lines 45-66] for providing an implemented function and suppressing other ones of the at least two different functions, wherein the pre-definable code includes information pertaining to a waiting time (idle time slot) [see Col. 6, Lines 27-50] corresponding to a period of time after which a switch is made from the function to be implemented to a further function of the at least two different functions, the further function being suppressed during the period of time (= the switching system includes a central switch 2055 with control unit 2061 for providing switch communication between different selective switching units 2031 & 2032) [see Abstract and Figs. 4a-4b & 6 and Col. 9, Lines 33-67 and Col. 11, Lines 6-63].

Regarding claims 11-12, Ardon further teaches the method according to claim 10, wherein the at least two functions are implemented by at least two different signals applicable to the terminal of the control unit, one signal of the at least two different signals of the function to be implemented is selected by the pre-definable code and applied to the terminal, and other ones of the at least two different signals are suppressed and wherein one function of the at least two functions is implemented by a signal applicable to the terminal of the control unit, the signal of the function to be implemented is selected by the pre-definable code and applied to the terminal, and other ones of the at least two different functions are suppressed [see Col. 11, Lines 6-63 and Col. 14, Line 32 to Col. 15, Line 11].

Regarding claim 13, Ardon further teaches the method according to claim 10, wherein one of the at least two functions includes a use of the terminal of the control unit for providing a bidirectional communication connection of another control unit to the control unit [see Figs. 4a-4b].

Claim 15 is rejected under the same rationale set forth above to claim 10.

Regarding claim 16, Ardon further teaches the device according to claim 15, further comprising an arrangement for selecting and clearing a function path of a function to be implemented independently of a code and for suppressing the at least another function path [see Abstract and Col. 13, Line 51 to Col. 14, Line 20].

Regarding claim 17, Ardon further teaches the device according to claim 15, wherein the first function includes a signal output unidirectionally over the first function path [see Fig. 6].

Claim 18 is rejected under the same rationale set forth above to claim 13.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ardon et al (Hereafter, Ardon), U.S. Pat. No. 5,105,420.

Regarding claim 19, Ardon does teach suppressing the other one of the at least two different functions as shown in claim 10 above. Ardon does not explicitly teach suppressing the at least two different functions is done without resetting any hardware arrangement. However, it would have been obvious to one skilled in the art to suppress the at least two different functions by using software code without resetting any hardware arrangement.

Claim 20 is rejected under the same rationale set forth above to claim 19.

Response to Arguments

9. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons:

Applicant argues that in the whole document (Ardon) there is not shown that a predefined code is given and that this predefined code includes information which expresses a period of time, which is a waiting time after which a suppressed function is free on that line and the other function which was established in the period of time is now suppressed [see Remarks, Page 4].

The examiner respectfully disagrees. Based on the broadest reasonably interpretation, Ardon still teaches a method for selecting a function to be implemented at a terminal of a control unit, the method comprising the steps of selecting the function to be implemented from one of at least two different functions by using a pre-definable code for providing an implemented function and suppressing other ones of the at least two different functions, wherein the pre-definable code includes information pertaining to a waiting time corresponding to a period of time after which a switch is made from the function to be implemented to a further function of the at least two different functions, the further function being suppressed during the period of time. For example, Ardon discloses the switching system includes a central switch 2055 with control unit 2061 for providing switch communication between different selective switching units 2031 & 2032 [see Ardon, Abstract and Figs. 4a-4b & 6 and Col. 9, Lines 33-67 and Col. 11, Lines 6-63]. Of course, this will lead to the case when one control unit is selected and the other one is not selected (suppressed) during a period of time. Regarding a predefined code, Ardon discloses software module which is inherently existed to control switching paths and to manage time slots [see Figs. 1 & 4a-4b & 6 and Col. 5, Lines 45-66] wherein there is an idle time slot involving selecting paths [see Col. 6, Lines 27-50].

Claims 11-13 and 16-20 depend on independent claims 10 and 15 and therefore are rejected at least by virtue of their dependency on independent claim and by other reasons set forth above in the rejection. In addition, claims 19-20 are rejected under 35 U.S.C. 112 first and second paragraphs as shown above.

In view of the foregoing, the examiner asserts that the cited reference (Ardon et al, U.S. Pat. No. 5,105,420) does teach or suggest the subject matter recited in independent claim. Accordingly, the examiner respectfully maintains the rejections for claims 10-13 and 15-20 as shown above.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991.

The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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PRIMARY EXAMINER
Art Unit 2155
Feb 15, 2008